

**OFFICIAL** D9426**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re amendment to the RICK K. SOUTHERN et al. patent application

Serial No. 10/034,446

Examiner: Phi Dieu Tran A

Filed: December 26, 2001

Art Unit: 3637

**RECEIVED**  
CENTRAL FAX CENTERFor: METHODS FOR ATTACHING SOLID HARDWOOD  
FLOOR PLANKS TO CONCRETE FLOOR SURFACES

JUL 06 2004

Office Action mailed: April 15, 2004

Commissioner for Patents  
Box 1450  
Alexandria, VA 22313-1450**REQUEST FOR RECONSIDERATION**

Sir:

Responding to the PTO Office Action mailed April 15, 2004, applicants' here present the Declarations of Joseph J. Grady and Richard P. Hirsch under Rule 132 to overcome the PTO's rejection of claims 1-3, 5-7, 10 and 12, under Rule 35 U.S.C. §103.

As Mr. Grady's April 29, 2004 declaration states, Mr. Grady is an expert in the relevant field and, as such, is highly qualified to express the opinions that appear in his declaration.

Contrary to the PTO's assertions in the January 6, 2004 action, neither Greenway '238 nor Searer '554 teach the adhesives applicants claim. For example, applicants' adhesives did not exist during the 1930's when the Greenway patent issued. See enclosed Grady declaration, ¶3. The Greenway

Southern et al.  
Appl. No. 10/034,446  
July 2, 2004

'238 patent, as the PTO concedes, does not disclose applicants' nailing step, either. The Searer patent teaches that adhesives are unnecessary to secure floorboards to a concrete surface. See Grady declaration, ¶4.

Combining the Greenway and Searer patents would lead away from what applicants claim because Greenway uses mastics that are different in kind than the adhesives applicants claim, and that fail in actual use, and Searer teaches using no adhesives at all, only nails.

At paragraph 1, page 2, the PTO's April 15, 2004 Action concedes that the earlier rejection based on the Greenway and Searer patents is not supportable, and is withdrawn. The Taylor et al. '910 patent adds nothing to the teachings of Searer and Greenway. Taylor et al. do not disclose any flooring products of any kind. Taylor et al. do not disclose attaching floor planks 3 feet or more in length to concrete surface to form a floor, and do not disclose using the adhesives that applicants claim for any purpose, let alone for attaching such wood planks directly to a concrete surface. On the contrary, the Taylor et al. '910 patent relates to attaching sheet-rock made of non-wood material to studs to form a wall in a building structure.

See ¶6 of the Grady declaration, reading, as follows:

"6. The PTO's citation to the disclosure at col. 4:46-56 shows that the '910 patent is not analogous to flooring products. There, the '910 patent discloses attaching insulating material, such as sheet-rock or drywall panels, to studs to form a wall in a building structure. These panels are not made of wood, and are not wood planks. The studs are not made of concrete, but of wood. In my opinion, flooring professionals would not look to, or rely on these teachings to come

D9426

up with the flooring products/processes disclosed in the claims attached as Exhibit 2. The adhesives referred to in the '910 patent are different from, and not interchangeable with, the adhesives identified in the claims of the above-identified application."

See also the enclosed July 2, 2004 Hirsch Declaration, ¶4, reading as follows:

"4. The adhesives disclosed in the Taylor patent for attaching simulated bricks to drywall surfaces to formal wall are called, at column 1, line 59, "waterproof epoxy resin adhesive materials." The only other mention of adhesive materials in the Taylor patent is at column 5, line 9, where Taylor refers to "suitable epoxy resin matrix or adhesive M." These adhesives are not water resistant or water impermeable as called for in the claims of the above-identified application. Rather, as our expert, Joseph J. Grady, attests at paragraph 6 of his Declaration: "The adhesives referred to in the '910 patent (the Taylor patent) are different from, and not interchangeable with, the adhesives identified in the claims of the above-identified application."

The PTO's reliance on Taylor for alleged disclosure of applicant's adhesives as claimed is utterly misplaced.

See also Mr. Hirsch's Declaration, ¶5, attesting to the outstanding commercial success of the claimed products/methods:

"5. The products and methods that are the subject matter of our pending claims in the above-identified application have achieved

D9426

outstanding commercial success. Since June 2002, the assignee of the above-identified application has taken more than 1,000 orders for such products/methods for more than 546,000 square feet of planking on concrete, resulting in more than \$9.3 million in sales. This success is directly attributable to the subject matter of the claims of this application."

This additional evidence of non-obviousness removes all doubt: applicant's claims are unobvious and patentable.

In addition, in Mr. Grady's opinion, the Taylor et al. '910 patent is non-analogous to the flooring claims in this application, and is from a field non-analogous to flooring. The Taylor et al. '910 patent attaches sheet rock/drywall to studs to make walls, not floors, and is therefore wholly unrelated to the subject matter claimed in this application, which is confined to the flooring products and methods of making flooring products. In fact, the Taylor et al. '910 patent is far less relevant, alone or taken with Greenway and Searer, than was the now-withdrawn Anderson et al. patent that the PTO cited in the January 6, 2004, action in combination with the same Greenway and Searer patents. Respectfully, applicants request withdrawal of the §103 rejection in the April 15, 2004 action for these reasons.

//

//

//

D9426

Applicants respectfully request reconsideration and allowance of all pending claims. Applicants' counsel would welcome a telephone call at any time to discuss any issue.

Respectfully submitted,

Dated: July 2, 2004

*Patrick Bright*  
Patrick F. Bright,  
BRIGHT & LORIG, P.C.  
633 West 5th St., Ste 3330  
Los Angeles, CA 90071  
Tel: 213.627.7774  
Fax: 213.627.8508